



UNITED STATES PATENT AND TRADEMARK OFFICE

HE  
UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,707	08/02/2001	Ben Byrd	41872-206195	6769

7590 09/17/2002

J. Michael Boggs  
Kilpatrick Stockton LLP  
1001 West Fourth Street  
Winston-Salem, NC 27101-2400

EXAMINER

PATTERSON, MARIE D

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 09/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/920,707	BYRD, BEN	
Examiner	Art Unit		
Marie Patterson	3728		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-34 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All
  - b) Some \*
  - c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____.
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> .	6) <input type="checkbox"/> Other: _____.

***Claim Rejections - 35 USC § 112***

1. Claims 2, 4, 7, 9-13, 15, 17, 20, 22-26, 28, and 31-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2, 15, and 28 are vague and indefinite because they define the shoe and/or method in reference to "proper placement of a heel" which is an undefined element. It is not clear what further structural limitations applicant intends to encompass with such language.

In claims 4 and 17 the phrase "permanently integrated" is vague and indefinite because it is not clear what structural limitations applicant intends to encompass with such language. Everything can be considered permanent if it is never removed.

In claims 7, and 12 the phrase "on each of a left and a right shoe of a pair of shoes" contradicts the preamble of "The shoe..." rendering the claims vague and indefinite because it is not clear if applicant is claiming a single shoe or a pair of shoes.

Claims 9-11, 22-24, 32, and 33 are vague and indefinite and it is not clear what further structural limitations applicant intends to encompass with such language.

In claims 11, 12, 24, and 25 the phrase "patterns having appeal to the age group and gender that would typically wear the shoe sizes" is vague and indefinite because it claims the shoe in reference to an appeal of a person which is undefined, unknown, and unbounded.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in–

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or  
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

3. Claims 1-5, 7, 9-11, 14-18, 20, 22-24, 27-29, 32, and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Toe Zone Scale (American Shoemaking reference).

The Toe Zone Scale shoes shows a shoe sole and method of using the shoe soles having a heel indicator and a plurality of lines indicating a plurality of sizes, i.e. less than the zone area is a smaller size, the zone area is the size of the actual shoe, and beyond the zone is a larger size as claimed.

4. Claims 1-5, 7, 9-11, 14-18, 20, 22-24, 27-29, 32, and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by Coplon (6415530).

Coplon shows shoe soles and method of using shoe soles having a heel indicator (14) and a plurality of lines (22, 24, and 26) indicating a plurality of sizes as claimed.

5. Claims 1-5, 7, 9-11, 14-18, 20, 22-24, 27-29, 32, and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Berger (5084988).

Berger shows shoe soles and method of using shoe soles having a heel indicator (boundary between elements 4 and 5), and a plurality of lines (6 and boundary between elements 3 and 5) with indicia (7) as claimed.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 6, 12, 19, 25, 30, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over "The Toe Zone Scale", Coplon, or Berger.

"The Toe Zone Scale", Coplon, or Berger shows shoe soles and method of using such substantially as claimed except for printing the actual size of the shoe on the bottom of the shoe sole. It is extremely well known and conventional to print the shoe size on the bottom of soles. It would have been obvious to print the shoe size on the outsole as is well known and conventional in the shoes of either "The Toe Zone Scale", Coplon, or Berger to make it easier to locate properly sized shoes.

8. Claims 8, 13, 21, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over "The Toe Zone Scale", Coplon, or Berger in view of either Rosen (4931773) or Sigoloff (4712314).

"The Toe Zone Scale", Coplon, or Berger shows shoe soles and method of using such substantially as claimed except for providing a transparent layer over the bottom of

the outsole. Rosen or Sigoloff teaches providing a transparent layer (36 or 26) on an outsole over an area of indicia. It would have been obvious to provide a transparent layer as taught by Rosen or Sigoloff in the shoes and method of "The Toe Zone Scale", Coplon, or Berger to increase the durability and to make the indicia easier to read after the shoes have been worn.

1. Telephone inquiries regarding the status of application or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the Examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148 or the **Tech Center 3700 Customer Service Center number is (703) 306-5648**. For applicant's convenience, the Group Technological Center FAX number is (703) 872-9302. (Note that the Examiner **cannot** confirm receipt of faxes) Please identify Examiner \_\_\_\_\_ of Art Unit \_\_\_\_\_ at the top of your cover sheet of any correspondence submitted.

Inquiries only concerning the **merits** of the examination should be directed to Marie Patterson whose telephone number is (703) 308-0069.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g. copies of references cited, form PTO-1449, for PTO-892, etc. requests for copies of such papers should be directed to Valerie Douglas at (703) 308-1337.

Check out our web-site at "www.uspto.gov" for fees and other useful information.



Marie Patterson  
Primary Examiner  
Art Unit 3728